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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,100	12/20/1999	HENRY WHITFIELD	ADEX0001	8312

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GLENN PATENT GROUP
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EXAMINER

HUSEMAN, MARIANNE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Priority: Dec 24 98

Office Action Summary

Application No.

09/472,100

Applicant(s)

WHITFIELD, HENRY

Examiner

M. Huseman

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 – 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The terms "public key" identifier and "private key" in claims 1 and 16 are used by the claim to mean an identifying number (e.g., an account number) while the accepted meaning is "a code used to **encrypt** a 'message' such that a private key (also a code) is needed to **decrypt** that 'message'". Applicant is respectfully requested to change those terms used throughout the specification and claims to a term more in keeping with Applicant's intended meaning. *partial tracking*

In claim 2, line 4, there is no proper antecedent basis for "authorization module". Perhaps the term "authorization" should be changed to - authentication -.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 9, 15 - 24 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Tedesco et al '286.

Regarding claims 1, 6, 9, 15, 16, 21, 24 and 30:

Tedesco et al teach a method and apparatus for processing checks such that Applicant's certificate authority reads on the bank device, element 12, figures 1 and 2,

Applicant's certificate issuance module reads on element 14 wherein Applicant's issued certificate reads on the reserved check, Applicant's public key identifier reads on the account identifier, Applicants' redemption denomination reads on the amount of funds reserved for the check, Applicant's private key reads on the reservation code, Applicant's certificate authentication module reads on element 16 wherein Applicant's authorization reads on the payee, element 16, providing to the bank, element 12 an account identifier, the redemption denomination (requested amount/amount of check); see paragraph [0060], starting at line 11, and the reservation code; see paragraph [0051], particularly the last sentence, and Applicant's means to cancel reads on the bank indicating that the check has been paid/claimed, paragraph [0064].

Regarding claims 2 and 17:

Applicant's second public key identifier reads on the check identifier, paragraph [0051]. The bank stores records of the reserved checks including the check identifier, paragraph [0039].

Regarding claims 3, 4, 18 and 19:

Applicant's payment agent reads on the financial account, paragraph [0047], from which the user wishes to use for payment of the reserved check. See also/instead paragraph [0075] wherein a user credit card can be used to charge a fee for the reserved check.

Regarding claims 5 and 20:

Applicant's authorization to transfer funds is considered inherent to the system of Tedesco et al, paragraphs [0047] and [0082].

Regarding claims 7, 8, 22 and 23:

Applicant's means to deliver reads on the inherent printed check as hinted at throughout the disclosure of Tedesco et al; see the "abstract" and paragraphs [0020, 0061 and 0063].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 – 14 and 25 - 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tedesco et al '286 in view of Walker et al '155.

Although Tedesco et al do not specifically teach that the check is transferable to another user prior to redemption, Walker et al teach a system for issuing and managing gift certificates (the certificates are considered to be used and handled similarly to the checks of Tedesco et al), such that Walker et al disclose that a security code, selectable either by the certificate issuer (bank of Tedesco et al) or the user/purchaser of the certificate, is necessary for the redemption of a gift certificate as is required in Tedesco et al. Further, Walker et al discloses that the certificate is transferable to another user, other than the purchaser. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention, if not inherent to the teachings of Tedesco et al, to allow the check of Tedesco et al to be transferred to another (as well as the reservation code) prior to redemption as is taught by Walker et al, as transferring of either checks or gift certificates is considered to be a common occurrence with either checks or gift certificates; see also, Walker et al "Description of the Related Art".

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sachs discloses transferring, receiving and utilizing electronic gift certificates.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

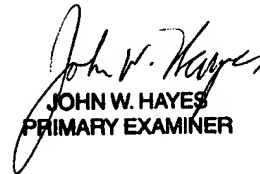
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



M. Huseman
Examiner
Art Unit 3621

mh
April 16, 2003



JOHN W. HAYES
PRIMARY EXAMINER